



PERKINS COIE LLP
POST OFFICE BOX 1208
SEATTLE WA 98111-1208

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OFFICE OF PETITIONS

In re Patent No. 7,544,512

Issued: June 9, 2009

Application No. 10/761,717

Filed: January 20, 2004

Attorney Docket No. 57783.8004.US00

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: DECISION ON APPLICATION :
: FOR PATENT TERM ADJUSTMENT :
:
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This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT RECONSIDERATION UNDER 37 C.F.R. §1.705(D)" filed July 28, 2009, requesting that the patent term adjustment determination for the above-identified patent be changed from two hundred forty-six (246) days to five hundred sixty-three (563) days. This request is based in part on the Office taking in excess of three years to issue the patent.

The request for reconsideration of patent term adjustment is **GRANTED TO THE EXTENT INDICATED HEREIN.**

For the reasons stated herein, no correction to the patent term adjustment is required.

Patentees acknowledge the failure of the Office to mail a response (non-Final Office Action in this matter) within four months of the applicant's response filed January 17, 2006. However, patentees argue that the response was filed January 17, 2006 and not January 7, 2006 as indicated by the Office. Thus the Office has incorrectly accorded 85 days for Office delay to the filing of the non-Final Office Action on July 30, 2006. Patentees assert that the correct number of days of Office delay is 75 in accordance with 37 CFR 1.702(a)(2).

85 days accorded for Office delay has been found to be incorrect. A review of the application file reveals that, as stated by applicants, their response to the Restriction Requirement mailed November 17, 2005 is of record in the application with a date of receipt by the Office of January 17, 2006 and that four months from that date would have been May 17, 2006. Thus, the Office delay from May 17, 2006 until the mailing of the non-Final Action on July 30, 2006 is seventy-five (75) days. The period of Office delay of 85 days has been removed and a period of Office delay of 75 days has been entered.

On June 9, 2009, the above-identified application matured into US Patent No. 7,544,512 with a patent term adjustment of 246 days. This request for reconsideration of patent term adjustment was timely filed within two months of the issue date of the patent. See 37 CFR 1.705(d).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Patentees request recalculation of the patent term adjustment based on the decision in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008). Patentees assert that in view of the decision in Wyeth, they are "entitled to a total patent term adjustment of 563 days, which includes 871 days of patent term adjustment due to exceeding three year pendency and 317 days due to USPTO delay in prosecution."

The 871-day period is calculated based on the application having been filed under 35 U.S.C. 111(a) on January 20, 2004, and the patent having been issued on June 9, 2009, three years and 871 days later. Patentees assert that in addition to this 871-day period, they are entitled to a period of adjustment due to examination delay pursuant to 37 CFR 1.702(a), of 317 days for the failure by the Office to mail at least one of a notification under 35 U.S.C. 132, pursuant to 37 CFR 1.702(a)(1) and (a)(2).

Under 37 CFR 1.703(f), patentees are entitled to a period of patent term adjustment equal to the period of delays based on the grounds set forth in 37 CFR 1.702 reduced by the period of time equal to the period of time during which patentees failed to engage in reasonable efforts to conclude prosecution pursuant to 37 CFR 1.704. In other words, it is the period of Office delay reduced by the period of applicant delay. Patentees do not dispute the period of reduction of 625 days for applicant delay.

Patentees do not dispute that the total period of Office delay is the sum of the period of Three Years Delay (871 days) and the period of Examination Delay (317 days) to the extent that these periods of delay are not overlapping. However, in effect, patentees contend that no portion of the Three Year Delay period overlaps with the period of examination delay. Accordingly, patentees submit that the total period of adjustment for Office delay is 1188 days, which is the sum of the period of Three Year Delay (871 days) and the period of Examination Delay (317 days), reduced by the period of overlap (0 days). As such, patentees assert entitlement to a patent term adjustment of 563 days (871 + 317 reduced by 0 overlap – 625 (applicant delay)).

The Office agrees that as of the issuance of the patent on June 9, 2009, the application was pending three years and 871 days after its filing date. The Office agrees that the action detailed above was not taken within the specified time frame, and thus, the entry of a period of adjustment of 317 days is correct. At issue is whether patentees should accrue 871 days of patent term adjustment for the Office taking in excess of three years to issue the patent, as well as 317 days for Office failure to take a certain action within a specified time frame (or examination delay).

The Office contends that 871 days overlap. Patentees' calculation of the period of overlap is inconsistent with the Office's interpretation of this provision. 35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

to the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

Likewise, 35 CFR 1.703(f) provides that:

To the extent that periods of delay attributable to the grounds specified in § 1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed.

As explained in *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004), the Office interprets 35 U.S.C. 154(b)(2)(A) as permitting either patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)-(iv), or patent term adjustment under 35 U.S.C. 154(b)(1)(B), but not as permitting patent term adjustment under both 35 U.S.C. 154(b)(1)(A)(i)-(iv) and 154(b)(1)(B). Accordingly, the Office implements the overlap provision as follows:

If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See *Changes to Implement Patent Term Adjustment Under Twenty Year Term; Final Rule*, 65 Fed. Reg. 56366 (Sept. 18, 2000). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 18, 2004). See also *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004).

The current wording of § 1.703(f) was revised in response to the misinterpretation of this provision by a number of Patentees. The rule was slightly revised to more closely track the corresponding language of 35 U.S.C. 154(b)(2)(A). The relevant portion differs only to the

extent that the statute refers back to provisions of the statute whereas the rule refers back to sections of the rule. This was not a substantive change to the rule nor did it reflect a change of the Office's interpretation of 35 U.S.C. 154(b)(2)(A). As stated in the *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, the Office has consistently taken the position that if an application is entitled to an adjustment under the three-year pendency provision of 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending before the Office (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A).

This interpretation is consistent with the statute. Taken together the statute and rule provide that to the extent that periods of delay attributable to grounds specified in 35 U.S.C. 154(b)(1) and in corresponding § 1.702 overlap, the period of adjustment granted shall not exceed the actual number of days the issuance of the patent was delayed. The grounds specified in these sections cover the A) guarantee of prompt Patent and Trademark Office responses, B) guarantee of no more than 3-year application pendency, and C) guarantee or adjustments for delays due to interference, secrecy orders and appeals. A section by section analysis of 35 U.S.C. 154(b)(2)(A) specifically provides that:

Section 4402 imposes limitations on restoration of term. In general, pursuant to [35 U.S.C.] 154(b)(2)(A)-(C), total adjustments granted for restorations under [35 U.S.C. 154(b)(1)] are reduced as follows: (1) To the extent that there are multiple grounds for extending the term of a patent that may exist simultaneously (e.g., delay due to a secrecy order under [35 U.S.C.] 181 and administrative delay under [35 U.S.C.] 154(b)(1)(A)), the term should not be extended for each ground of delay but only for the actual number of days that the issuance of a patent was delayed; See 145 Cong. Rec. S14,718¹

As such, the period for over three-year pendency does not overlap only to the extent that the actual dates in the period beginning three years after the date on which the application was filed overlap with the actual dates in the periods for failure of the Office to take action within specified

¹ The AIPA is title IV of the Intellectual Property and Communications Omnibus Reform Act of 1999 (S. 1948), which was incorporated and enacted as law as part of Pub. L. 106-113. The Conference Report for H.R. 3194, 106th Cong. 1st Sess. (1999), which resulted in Pub. L. 106-113, does not contain any discussion (other than the incorporated language) of S. 1948. A section-by-section analysis of S. 1948, however, was printed in the Congressional Record at the request of Senator Lott, See 145 Cong. Rec. S14,708-26 (1999)(daily ed. Nov. 17, 1999).

time frames. In other words, consideration of the overlap does not begin three years after the filing date of the application

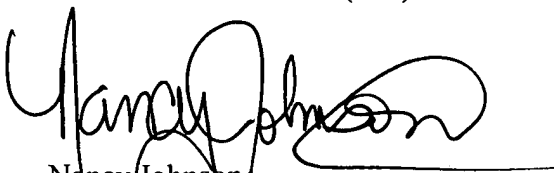
In this instance, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A) is the entire period during which the application was pending before the Office, January 20, 2004, to the date the patent issued on June 9, 2009. Prior to the issuance of the patent, 327 days (242 + 85 before correction) of patent term adjustment were accorded for the Office failing to respond within a specified time frame during the pendency of the application. All of the 871 days for Office delay in issuing the patent overlap with the 327 days of Office delay. The Office did not delay 327 days and then an additional 871 days. Entry of both periods is not warranted. Thus, 871 days is determined to be the actual number of days that the issuance of the patent was delayed.

Accordingly, at issuance, the Office entered 544 additional days of patent term adjustment due to the Three Year Delay by the Office, pursuant to 37 CFR § 1.703(b) for a total Office delay of 871 days (327 + 544).

Given the correction of the Office delay from 85 days to 75 days, the Office delay of record during the pendency of the application is 317 days. As such, 554 days, instead of 544 days, is being entered for Office delay pursuant to 37 CFR § 1.703(b) for a total Office delay of 871 days (317 + 554)

In view thereof, the revised patent term adjustment remains 246 days.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Patricia Faison-Ball at (571) 272-3212.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions